

REMARKS

Claims 1, 2, 4-19, 21, 23-29 and 33 are pending in this application. Claim 1 has been amended to better define the invention and to better illustrate the structure of the claimed roofing material. No new matter has been added by this amendment.

Claim 1 is rejected under 35 USC 103(a) over Head. This rejection has been obviated by the amendment to claim 1 which now further recites that “with a layer containing a resin distribution medium between abutting end faces and, wherein the fibre reinforced plastic connecting layer extends across the surfaces of both ends of said sandwich structures” after “wherein the two or more sandwich structures are butt joined in the widthwise direction by being integrally molded by a resin transfer molding”. This feature of the present invention is not taught, disclosed or suggested by Head or any reference cited by the Examiner or known to applicants. As described in the original specification on page 7, lines 6-17, and illustratively shown by Figure 26, the claimed embodiment of the invention brings about advantages over the prior art, in which mechanical connections, such as ordinary bolts, are used to join roofing materials (see the paragraph bridging pages 19 and 20).

Claims 1-5, 10-19, 21, 23-25, and 33 are rejected under 35 USC 103(a) over Rothman. In view of the amendment to claim 1, this rejection is also moot. Rothman does not teach a layer containing a resin distribution medium between abutting end faces and a fibre reinforced plastic connecting layer extends across the surfaces of both ends of said sandwich structures. For that reason, Rothman, alone, cannot create a *prima facie* case of obviousness with respect to the claims as amended.

Further, the Examiner has contended that the claimed feature of “integrally molded by a resin transfer process” is merely a process limitation to be given little or no patentable weight. However, the Office Action dated January 16, 2004 indicates that the Supplemental Amendment filed on December 23, 2003 has not yet been considered. In the Supplemental Amendment, it was made clear that the two or more sandwich structures are butt joined in the widthwise direction by being also integrally molded by a resin transfer molding. Applicants believe that the Examiner would give a favorable consideration to this limitation and also believe that the claims, claims, as further amended, show structure sufficient to be allowable over the prior art, since the

joining of members by a resin transfer process as now amended is, in fact a structural limitation that the Examiner must consider in evaluating the present claims. In *In re GARNERO*, 56 C.C.P.A. 1289 (1969), the Court of Customs and Patent Appeals stated, that a limitation should be viewed with regard to the manner in which it affects the structure of claim. In this instance, the Examiner should view the structure of the claimed members and how they are bonded to one another with regard to the structure created by the resin transfer molding process (i.e., a product-by-process limitation). Obviously, were the various members bonded by nuts and bolts rather than resin transfer molding, the structure of the claimed article would be quite different. Where, as here, the structure of an article can only be adequately described by the means by which it was created, the Examiner is required to assess the patentability of the article based on the structure created by the resin transfer molding process. As stated in the original specification, this molding process creates an article with different physical properties than articles created by other methods – properties which include lighter weight, greater structural integrity, and improved appearance. For these reasons, the Examiner kindly requested to give consideration to the structure associated with an article having the presently claimed limitations and not discount the disclosed resin transfer molding process as a mere process limitation.

All claims are now in condition for allowance and a notice thereof is earnestly solicited.

In the event that the transmittal letter is separated from this document and the Patent & Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge

the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, referencing 360842007000. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: June 1, 2004

Respectfully submitted,

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